

**TERMINAL DISCLAIMER TO OBIATE A PROVISIONAL DOUBLE PATENTING
REJECTION OVER A PENDING "REFERENCE" APPLICATION**

Docket Number (Optional)

1842-0019

In re Application of: Johnson et al.

Application No.: 10/623,957

Filed: July 21, 2003

For: TISSUE DISTRACTION DEVICE

The owner*, Spine Wave, Inc., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number 10/458,174, filed on June 10, 2003, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the **reference** application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of any patent granted on said **reference** application, "as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application," in the event that: any such patent: granted on the pending **reference** application: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 32,722

/Michael D. Beck/

Signature

Sept. 19, 2007

Date

Michael D. Beck

Typed or printed name

317-638-2922

Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this statement. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

STATEMENT UNDER 37 CFR 3.73(b)Applicant/Patent Owner: Spine Wave, Inc.Application No./Patent No.: 10/458,174 Filed/Issue Date: June 10, 2003Entitled: TISSUE DISTRACTION DEVICE

Spine Wave, Inc., a Corporation
 (Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of less than the entire right, title and interest
 (The extent (by percentage) of its ownership interest is _____ %)

in the patent application/patent identified above by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: _____ To: _____
 The document was recorded in the United States Patent and Trademark Office at
 Reel _____, Frame _____, or for which a copy thereof is attached.
2. From: _____ To: _____
 The document was recorded in the United States Patent and Trademark Office at
 Reel _____, Frame _____, or for which a copy thereof is attached.
3. From: _____ To: _____
 The document was recorded in the United States Patent and Trademark Office at
 Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

- ☒ As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

<u>/Michael D. Beck/</u>	<u>Sept. 19, 2007</u>
Signature	Date
<u>Michael D. Beck</u>	<u>317-638-2922</u>
Printed or Typed Name	Telephone Number
<u>Attorney/agent Reg. No. 32,722</u>	
Title	

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

ASSIGNMENT

We, Wes Johnson, Tyler Lipschultz, Larry Wales and Robert Kieval, citizens of the United States residing at 8091 Spruce Trail, Eden Prairie, Minnesota 55347; 15 South 1st Street #A1119, Minneapolis, MN 55401; 1654 Currie Street, Maplewood, Minnesota 55119; and 850 Foxberry Circle, Medina, Minnesota 55340, respectively, have made an invention relating to (title): TISSUE DISTRACTION DEVICE and have executed an application for United States Letters Patent based thereon and identified by attorney's File No. 44864.1 and naming the following inventors: Wes Johnson, Tyler Lipschultz, Larry Wales and Robert Kieval; Application No. 09/872,905, filed June 1, 2001.

In exchange for good and valuable consideration, the receipt of which we now acknowledge, we hereby assign to VERTx, Inc., a Delaware corporation with offices at 6765 Wedgwood Road, Suite 100, Maple Grove, Minnesota 55311, its successors and assigns (hereinafter "Assignee"):

- (1) The entire right, title and interest to the above-identified invention and application;
- (2) The entire right, title and interest to any United States or foreign Letters Patents which may issue with respect to the above identified invention;
- (3) The entire right, title and interest to any renewals, reissues, extensions, substitutions, continuations, continuations-in-part, or divisions that may be filed with respect to the above identified invention and application; and
- (4) The right to apply for Letters Patents in foreign countries in its own name and to claim any priority rights to which such foreign applications are entitled under international conventions, treaties or otherwise.

We further agree for ourselves and for our heirs, executors and administrators, to execute and deliver without further consideration any further applications, assignments or other documents and to perform such other lawful acts as Assignee, its successors and assigns may deem necessary to fully secure, maintain and enforce its rights, title or interest as outlined herein.

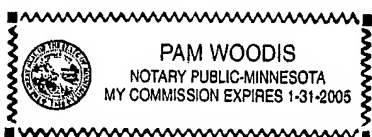
We hereby authorize and request the Commissioner of Patents and Trademarks to issue to Assignee any Letters Patents which may be granted in accordance with this Assignment.

Dated this 12 day of July, 2001.

Wes Johnson

Subscribed and sworn to before me
this 12 day of July, 2001.

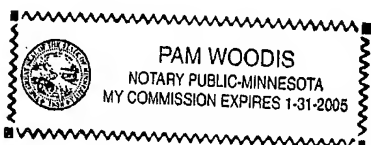
Pam Woods
Notary Public



Tyler Lipschultz
Tyler Lipschultz

Subscribed and sworn to before me
this 12 day of July, 2001.

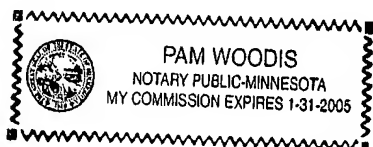
Pam Woods
Notary Public



Larry Wales
Larry Wales

Subscribed and sworn to before me
this 12 day of July, 2001.

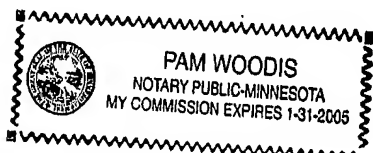
Pam Woods
Notary Public



Robert Kieval
Robert Kieval

Subscribed and sworn to before me
this 12 day of July, 2001.

Pam Woods
Notary Public



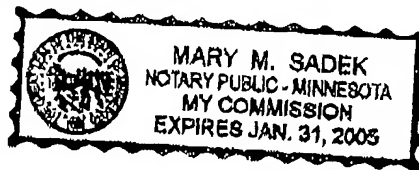
We hereby authorize and request the Commissioner of Patents and Trademarks to issue to Assignee any Letters Patents which may be granted in accordance with this Assignment.

Dated this 11 day of July, 2001.

Wes Johnson
Wes Johnson

Subscribed and sworn to before me this 11th day of July, 2001.

Mary M. Sadek
Notary Public



Tyler Lipschultz

Subscribed and sworn to before me this _____ day of _____, 2001.

Notary Public

Larry Wales

Subscribed and sworn to before me this _____ day of _____, 2001.

Notary Public

Robert Kieval

Subscribed and sworn to before me this _____ day of _____, 2001.

Notary Public

Delaware

PAGE 1

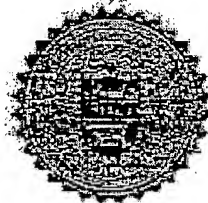
The First State

I, HARRIET SMITH WINDSOR, SECRETARY OF STATE OF THE STATE OF DELAWARE, DO HEREBY CERTIFY THE ATTACHED IS A TRUE AND CORRECT COPY OF THE CERTIFICATE OF MERGER, WHICH MERGES:

"VERTEX, INC.", A DELAWARE CORPORATION,

WITH AND INTO "SPINE WAVE, INC." UNDER THE NAME OF "SPINE WAVE, INC.", A CORPORATION ORGANIZED AND EXISTING UNDER THE LAWS OF THE STATE OF DELAWARE, AS RECEIVED AND FILED IN THIS OFFICE THE TWENTIETH DAY OF MARCH, A.D. 2002, AT 9 O'CLOCK A.M.

A FILED COPY OF THIS CERTIFICATE HAS BEEN FORWARDED TO THE KENT COUNTY RECORDER OF DEEDS.



Harriet Smith Windsor
Harriet Smith Windsor, Secretary of State

3358701 8100M

AUTHENTICATION: 1675858

020182089

DATE: 03-20-02

CERTIFICATE OF MERGER OF

VERTx, INC.
(a Delaware Corporation)

STATE OF DELAWARE
SECRETARY OF STATE
DIVISION OF CORPORATIONS
FILED 09:06 AM 03/20/2002
020162089 - 3358701

WITH AND INTO

SPINE WAVE, INC.
(a Delaware Corporation)

**(UNDER SECTION 251 OF THE GENERAL CORPORATION LAW
OF THE STATE OF DELAWARE)**

The undersigned corporation organized and existing under and by virtue of the General Corporation Law of the State of Delaware, does hereby certify that:

1. The name and state of incorporation of each of the constituent corporations of the merger is as follows:

<u>Name</u>	<u>State of Incorporation</u>
VERTx, Inc.	Delaware
Spine Wave, Inc.	Delaware

2. An Acquisition Agreement and Plan of Merger (the "Merger Agreement") between the parties to the merger has been approved, adopted, certified, executed and acknowledged by each of the constituent corporations in accordance with the requirements of Section 251 of the General Corporation Law of the State of Delaware.

3. Spine Wave, Inc., a Delaware corporation, shall continue in existence as the surviving corporation in the merger.

4. As a result of the merger, the Certificate of Incorporation of Spine Wave, Inc. as the surviving corporation shall be its Certificate of Incorporation.

5. The executed Merger Agreement is on file at the principal place of business of the surviving corporation, the address of which is 12236 El Camino Real, Suite 300, San Diego, California 92130.

6. A copy of the Merger Agreement will be furnished by the surviving corporation on request and without cost, to any stockholder of either constituent corporation.

IN WITNESS WHEREOF, Spine Wave, Inc., a Delaware corporation, has caused this Certificate to be signed by Mark LoGuidice, its President on March 20, 2002.

SPINE WAVE, INC.,
a Delaware corporation

By: 

Name: Mark LoGuidice

Title: President